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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,152	09/20/2000	Kimiyuki Shibuya	49218-C	7703

7590 07/19/2002

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EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 07/19/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.



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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on July 3, 2002

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~or this date~~, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 9-18 are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 9-18 are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e)

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

C9/666,152

DETAILED ACTION

Claims 9-18 are pending in the application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 13, 2002 has been entered.

Election/Restrictions

Applicants' election with traverse of Group V in Paper No. 4 was acknowledged in Paper No. 5. Subject matter not embraced by elected Group V is withdrawn from further consideration pursuant to 37 CFR

1.142(b), as being drawn to nonelected inventions. Applicant timely traversed the restriction (election) requirement in Paper No. 4.

It is suggested that in order to advance prosecution, the non-elected subject matter be canceled when responding to this Office Action.

Rejections made in the previous Office Action that do not appear below have been overcome.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13 and 15-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 does not further limit claim 12. In claim 15, "The method" should be changed to "A method". Further in claim 15, it would appear that something is missing from the phrase "aortic aneurysm in need of such treatment".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable Hirai et al. {JP 04-139172}. An English translation of Hirai et al. was supplied with a previous Office Action.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicants claim benzoxazole compounds. Hirai et al. teach benzoxazole compounds which are structurally similar to the instant claimed compounds. See in Hirai et al., for example, wherein R¹-R⁴ are each hydrogen, A is oxygen, R⁵ is alkyl, and R⁶ is a substituted heteroaryl

group (pages 1 and 2 of the Japanese patent and pages 6 and 16 of the English translation). Also see, for example, compounds 5, 9, 17, 18, 34, 71, 72 and 77 in the Table on pages 7 and 8 of the Japanese patent.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the compounds in the prior art and the compounds instantly claimed is that of positional isomerism (the instant n is 2 whereas R^5 is methyl in the prior art and the $-C(O)NHR^6$ group is attached to the fixed carbon, $-CHR^5$). In other words, the instant claimed compounds, for example, have an "ethylene" group $\{-CH_2CH_2-\}$ whereas the prior art teaches an "ethyldenyl" group $\{-CH(CH_3)-\}$.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

Nothing unobvious is seen in substituting the known claimed isomer for the structurally similar isomer, as taught by Hirai et al., since such structurally related compounds suggest one another and would be

expected to share common properties absent a showing of unexpected results. In re Norris, 84 USPQ 458 (1950).

One skilled in the art would have been motivated to prepare positional isomers of the compounds in the reference genus to arrive at the instant claimed compounds with the expectation of obtaining additional beneficial compounds that would be useful in treating ulcers. Therefore, the instant claimed compounds would have been suggested to one skilled in the art.

Response to Arguments

Applicants' arguments filed July 3, 2002 have been fully considered. In regard to claim 13 not further limiting claim 12, Applicants argue that claim 13 recites compounds of claim 12 further possessing specific activity against one or more specific indications. In response, on page 9, last two lines on the page and page 10, lines 1-5 of the instant specification states that the compounds of formula (I) are useful as ACAT inhibitors (also see page 11, the last paragraph on the

page). It would appear at all of the compounds of formula I have the same activities that are listed in claim 13. Therefore, this rejection is maintained.

Applicants argue that Hirai et al. neither teach nor suggest the instant compounds of Formula I and pharmaceutical compositions comprising such compounds. Applicants argue that the instant claimed compounds are not structurally similar to Hirai et al. Applicants argue that the compounds of the prior art have a different utility. Applicants argue that Hirai et al. neither disclose nor suggest compounds of the instant invention having an alkylene linker with more than one carbon between the instant Y and Z group.

Applicants' arguments have been considered but have not been found persuasive. Applicants claim benzoxazole compounds. Hirai et al. teach benzoxazole compounds which are structurally similar to the instant claimed compounds. See in Hirai et al., for example, wherein R^1 - R^4 are each hydrogen, A is oxygen, R^5 is alkyl, and R^6 is a substituted heteroaryl group (pages 1 and 2 of the Japanese patent and pages 6 and

16 of the English translation). Also see, for example, compounds 5, 9, 17, 18, 34, 71, 72 and 77 in the Table on pages 7 and 8 of the Japanese patent.

The difference between the compounds in the prior art and the compounds instantly claimed is that of positional isomerism. In other words, the instant claimed compounds, for example, have an "ethylene" group $\{-\text{CH}_2\text{CH}_2-\}$ whereas the prior art teaches an "ethyldenyl" group $\{-\text{CH}(\text{CH}_3)-\}$. Further, there is no requirement that the prior art must suggest that the claimed product will have the same or similar utility as that discovered by applicant in order to support a legal conclusion of obviousness. *In re Dillon*, 16 U.S.P.Q. 2d 1897, 1904 (Fed. Cir. 1990). Note that the instant method of use claims (claims 15-18) were not rejected under 35 U.S.C. § 103. For all the reasons given above, the instant claimed invention is found obvious over Hirai et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to

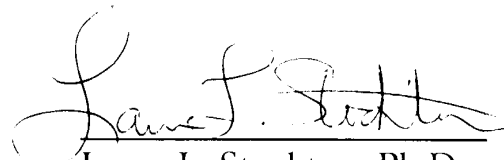
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2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235, 308-0196 or 305-3290.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556, 308-4242, 305-1935 or 308-2742.

A handwritten signature in cursive script, appearing to read "Laura L. Stockton", is written over a horizontal line.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

July 19, 2002